

Application No. 10/041,119  
Response dated September 18, 2003  
Reply to Office Action of June 18, 2003

### REMARKS

Claims 2-9 and 11-21 are pending in the application. Claims 2-9 and 11-21 stand rejected.

#### Claim Rejections - 35 U.S.C. §103

The Examiner rejected Claims 2-9, and 11-21 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,129,701 to Cimino (hereinafter "Cimino '701") and further in view of U.S. Patent No. 4,445,509 to Auth (hereinafter "Auth '509"). The Examiner indicated that Cimino '701 did not teach an external flute as claimed by Applicants and cited Auth '509 for teaching an external flute. The Examiner then concluded that it would have been obvious to one having ordinary skill in the art to have added external flutes to Cimino's '701 apparatus because according to Auth '509 external flutes allow for plaque and other obstructions to be removed from organic structures without damage to normal tissue.

Auth '509 discloses a method and apparatus for removal of "hard abnormal deposits while preserving soft normal tissue." U.S. Patent No. 4,445,509, column 1, lines 9-10. Contrary to Auth '509, Cimino '701 discloses a vented aspirator and method for removing soft tissue, not for preserving soft tissue as in Auth '509. Without conceding that the combined disclosures of Auth '509 and Cimino '701 disclose every element of Applicants pending claims, Applicants respectfully submit that a person of ordinary skill in the art would not be motivated to combine the disclosure of Auth '509 with Cimino '701 because Cimino '701 discloses a method of removing soft tissues from a patient, while Auth '509 teaches a method of removing hard deposits while preserving soft tissue.

To establish a *prima facie* case of obviousness, the Examiner must establish "some objective teaching in the prior art where the knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). "There is no suggestion to combine however if a reference teaches away from its combination with another source." Tec Air, Inc. v. Denso Manufacturing Michigan Inc., 192 F.3d 1353, 1360 (Fed. Cir. 1999).

Application No. 10/041,119  
Response dated September 18, 2003  
Reply to Office Action of June 18, 2003

A reference may be said to teach away when a person of ordinary skill, upon reading the reference would be discouraged from following the path set out in the reference, or be lead in a direction divergent from the path that was taken by the applicant . . . in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994).

In the patent application at issue, Applicants seek to provide a debridement extension for removing soft tissue. Auth '509 discloses a method and apparatus for removal of hard abnormal deposits while *preserving* soft tissue. Applicants respectfully submit that "the line of development flowing from the reference's [Auth '509] disclosure [preservation of soft tissue] is unlikely to be productive of the results sought by the Applicants [removal of soft tissue]." *Id.* Therefore, Auth '509 teaches away from its combination with Cimino '701. With the foregoing in mind, Applicants respectfully request withdrawal of the 35 U.S.C. §103 rejection of Independent Claims 5, 14, and 16 as well as Claims 2-4, 6-9, 11-13, 15, and 17 depending therefrom.

Independent Claim 18 calls for a debridement extension having a debridement tip including a plurality of irrigation apertures spaced about the periphery of the debridement tip at 90° intervals. Similarly, Independent Claim 20 calls for a debridement extension having a debridement tip with a plurality of suction apertures spaced about the periphery of the debridement tip at 90° intervals. The Examiner pointed Applicants to Figure 5 of Cimino '701 and indicated that the irrigation apertures of Cimino '701 are spaced about the periphery of the tip thereof in 90° intervals. Referring to Figure 5 of Cimino '701, there is disclosed a surgical instrument including central irrigation port 30. This figure does not depict a plurality of irrigation apertures spaced about the periphery of the tip in 90° intervals. Cimino '701 does not disclose or suggest a debridement extension having a debridement tip with a plurality of suction or irrigation apertures spaced about the periphery of the debridement tip in 90° intervals as called for in Independent Claims 18 and 20. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103 rejection of Claims 18 and 20 and Claims 19 and 21 depending therefrom.

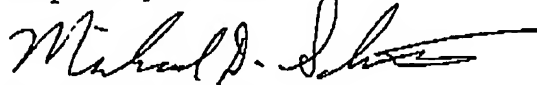
Application No. 10/041,119  
Response dated September 18, 2003  
Reply to Office Action of June 18, 2003

Applicants have rewritten Claim 6 in independent form. Claim 6 calls for, *inter alia*, a debridement extension including a debridement tip having a plurality of external longitudinal flutes, with each of the longitudinal flutes in fluid communication with at least one of a plurality of suction apertures. Even assuming *arguendo* that Auth '509 can properly be combined with Cirmino '701, these references in combination do not disclose or suggest the claimed configuration of Independent Claim 6 in which each of a plurality of external longitudinal flutes is in fluid communication with one of a plurality of suction apertures. Furthermore, Claim 6 is patentable over the cited references for the reasons advanced above with respect to Independent Claims 5, 14, and 16.

In the event Applicant has overlooked the need for an extension of time or payment of fee, Applicant hereby petitions therefor and authorizes that any charges be made to Deposit Account No. 02-0385, BAKER & DANIELS.

If any questions concerning this application should arise, the Examiner is encouraged to telephone the undersigned at 219/424-8000.

Respectfully submitted,



Michael D. Schwartz  
Registration No. 44,326  
Attorney for Applicant

MS/pas  
Enclosure(s):  
Postcard  
BAKER & DANIELS  
111 E. Wayne Street, Suite 800  
Fort Wayne, IN 46802  
Telephone: 219-424-8000  
Facsimile: 219-460-1700

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: MAIL STOP AF, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450, on: September 18, 2003

MICHAEL D. SCHWARTZ, NO. 44,326  
NAME OF REGISTERED REPRESENTATIVE



SIGNATURE  
September 18, 2003  
DATE